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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT PAPER NUMBER

2163

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,924

Applicant(s)

TU ET AL.

Examiner

Marc R. Filipczyk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Action is responsive to Applicant's RCE and amendment filed December 13 2005.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/13/05 has been entered.

Amended claims 1-18 are pending.

Specification

The amendment filed 12/13/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

1. material data object
2. storage bin data object associated with a storage bin for storing material associated with the material data object

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written **description requirement**. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding the amendment to the specification on pages 2-5, at least the features of: 1. material data object and, 2. storage bin data object associated with a storage bin for storing material associated with the material data object, were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner notes, that although the original specification does include “ a material” and “a corresponding storage bin for storing the material”, it does not include, anticipate or make obvious the subject matter of the current amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement requirement**. Claims 1-18 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The automatic storage and retrieval system (AS/RS) comprising “a material data object associated with a material”, “storage bin data object is associated with a material storage bin”, and “storage bin associated with said storage bin data object related to the material selected by the user” was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Claim Rejections - 35 USC § 112

Claims 1-18 are rejected under 35 U.S.C. 112, **second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 11, the segment, “storage bin data each including a material” is indefinite. Storage bin data each including a material is not definite because it is not clear what storage bin data and material are, and further it is not clear how the storage bin data and material are related to the communication network. Second, the segment “storage bin data object is associated with a material storage bin” is indefinite. It is not clear how the two are associated.

Further regarding claim 1, the feature, “material data object associated with a material” is indefinite. It is not clear what the metes and bounds of material data object are, and how they are associated. The steps beginning with “having” and “informing” are indefinite. It is not clear if any task is performed, further the metes and bounds of these terms are not clear.

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Further regarding claim 11, the segment, “logged-in the AS/RS” is indefinite. It is not clear if the identification number is used for logging in the system, further, it is not clear if the user logs into the system.

Regarding claims 2-10 and 12-18 depend from claims 1 and 11 respectively, and are therefore rejected on the same basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as best as the Examiner is able to ascertain as being unpatentable over Van Dyke et al (herein “Dyke”) (U.S. Patent No. 6,412,070).

Regarding claims 1, 5 and 11, Dyke discloses a method and system for operating an automatic storage and retrieval system (AS/RS) connected by a programmable logic controller (PLC) through a network (fig. 2, items 120, 125 and 145), the AS/RS has a first database (fig. 2, 125) to store data files (col. 5, lines 2-8 and col. 6, lines 20-24, Dyke), comprising:

sending and displaying data files on a user’s computer device after a user logged in the AS/RS through an identification number provided for the user, and receiving a selected data file from the data files by the user (fig. 6 and col. 6, lines 10-24);

searching for the data file's access permissions to compare and match with the user's security ID (col. 6, lines 18-24); and

granting or denying access to the data file based on the compared access permissions and user's security ID (col. 6, lines 25-56, Dyke), but does not explicitly teach the data file is associated with a material storage bin.

However, this difference is only found in the nonfunctional descriptive material and does not alter how the AS/RS and AS/RS logic controller perform functions (i.e., the descriptive material does not reconfigure any data). Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to associate data file to any type of data because such data does not alter how the AS/RS and AS/RS logic controller function and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding claims 2 and 13, Dyke discloses a second database (col. 6, lines 11-13).

Regarding claims 3 and 15, Dyke discloses storing a plurality of records, including the identification number of the user, login time and selected data (fig. 4 and col. 5, lines 30-35).

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Regarding claims 4 and 16, Dyke discloses the user's device is a computer (col. 4, lines 25-40).

Regarding claims 6, 7 and 17, Dyke discloses databases and a database server (fig. 2, items 120 and 125).

Regarding claims 8, 9, 12 and 14, Dyke discloses query statements (fig. 2 and col. 6, lines 20-24).

Regarding claims 10 and 18, Dyke discloses the communication network is internet or intranet (col. 4, lines 25-40).

Response to Arguments

Applicant's arguments filed on December 13, 2005 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant states on page 11 of the 12/13/2005 response regarding 35 U.S.C. 112, first and second paragraph rejections that they have been overcome by the current amendment.

Examiner disagrees. Many rejections are outstanding, in addition, new matter rejections are raised in response to Applicant's amended claims and specification. Applicant is reminded to comply with MPEP regulations: regarding amendments, Applicants are required to provide

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and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Applicant argues on page 11 of the 12/13/2005 response that Dyke fails to disclose a logic controller configured to operate on material storage bins.

Examiner disagrees. Applicant's claims comprise 35 U.S.C. 112, first and second paragraph rejections for new subject matter and indefinite terminology. In addition, Dyke discloses a logic controller for monitoring data files. For more information please refer to the rejections above.

Examiner notes previous arguments and responses on record which are related to the pending application, see below:

Applicant argues on page 2 of the 6/21/2005 response regarding U.S.C. 112 first paragraph rejections that, "The ERP system is well known to those skilled in the art and, thus the construction of the AS/RS used in the ERP system is also known to those skilled in the art. Therefore, the AS/RS comprising a database for storing storage bin data each including a material is also well known to those in the art."

Examiner disagrees. Applicant's argument of "ERP being well known to those skilled in the art, thus the construction of the AS/RS used in the ERP system is also known to those skilled in the art and, therefore, the AS/RS comprising a database for storing storage bin data each including a material is also well known to those in the art" is not analogous. Even if Applicant was correct regarding ERP and construction of AS/RS being well known, that does not render AS/RS comprising a database for storing storage bin data each including a material well known in the art. Further, Examiner rejected "the automatic storage and retrieval system (AS/RS) comprising a database for storing storage bin data each including a material" as not described in the specification or figures in such a way as to

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enable one skilled in the art to which it pertains to make and/or use the invention. In response, Applicant cites page 1, par. 2 and 3. Nothing in the cited paragraphs describes the automatic storage and retrieval system (AS/RS) comprising a database for storing storage bin data each including a material. Instead, the process of AS/RS PLC being manually operated by a user is broadly mentioned. The claimed aspect of automatic AS/RS comprising a database is not even suggested. Based on Examiner's discussion, the 35 U.S.C. 112 first paragraph rejections are sustained.

Applicant argues on pages 2 and 3 of the 6/21/2005 response regarding U.S.C. 112 second paragraph rejections that the segments 'the "storage bin data each including a material" and "a corresponding storage bin" are constructed in the AS/RS used in the ERP system' and that ERP is well known in the art.

Examiner disagrees. It is noted that the features upon which applicant relies (i.e., constructing and ERP) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, even if the "storage bin data each including a material" and "a corresponding storage bin" are constructed in AS/RS as alleged by the Applicant, it is still not clear what storage bin data and material are and what their function is.

Applicant argues on page 3 of the 6/21/2005 response regarding U.S.C. 112 second paragraph rejections that, "a daily required material report is displayed in a browser of the users' computer device via the AS/RS" and that the feature of "displaying via the AS/RS" is definite.

Examiner disagrees. The claimed segment, "displaying via the AS/RS" is not definite because it is not clear how a storage and retrieval system (AS/RS) is able to display data, as the claimed language clearly attempts to credit the AS/RS with a displaying feature. For more information, please see rejection.

Applicant argues on page 3 of the 6/21/2005 response regarding U.S.C. 112 second paragraph rejections pertaining to claim 11 that the feature of "logged-in the AS/RS" is definite since an identification number is given to a user "for logging onto the system".

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Examiner disagrees. It is noted that the features upon which Applicant relies (i.e., logging) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed language states, "a user is provided with an identification number for logged-in the AS/RS". It is not clear from the claimed language if the user is logged in to the system, and if yes, it is not clear if the identification number is used for logging the user into the system.

Applicant argues on page 4 of the 6/21/2005 response that, "Dyke does not display a daily required material report after the user logs on the system. Further, Dyke fails to disclose whether or not a user has the right to obtain selected material through the system."

Examiner disagrees. The features upon which Applicant relies are indefinite and are not enabling, see U.S.C. 112 rejections. Further, Dyke discloses displaying data files which are equivalent to daily required material when the user is logged in (fig. 1, items 47 and 48, fig. 2 and col. 6, lines 10-24 and abstract). Dyke further discloses whether or not a user has the right to obtain selected data file based on access permissions and user's security ID (fig. 6 and col. 6, lines 25-56).

No other arguments were raised.

With respect to all the pending claims 1-18, Examiner respectfully traverses Applicant's assertion based on the discussion and rejections cited above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
February 17, 2006


FRANTZ COBY
PRIMARY EXAMINER